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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* THOMAS L. DISTEFANO, III
9

10 Appeal 2009-000339
11 Application 09/589,551
12 Technology Center 3600
13
14

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16 Decided: ¹ June 15, 2009
17

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19 Before HUBERT C. LORIN, ANTON W. FETTING, and
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

23 STATEMENT OF THE CASE

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 Thomas L. Distefano, III (Appellant) seeks review under 35 U.S.C. § 134 of a
2 non-final rejection of claims 1-21, the only claims pending in the application on
3 appeal.

4 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

5
6 We AFFIRM-IN-PART.

7 The Appellant invented a way of assisting a website designer in establishing an
8 arrangement between a first website being designed by the website designer and a
9 second website to market the first website at the second website upon the
10 activation of the first website on the internet (Spec. 6:2-5).

11 An understanding of the invention can be derived from a reading of exemplary
12 claim 1, which is reproduced below [bracketed matter and some paragraphing
13 added].

14 1. A method of assisting a website designer in establishing an
15 arrangement between a first website being designed by the
16 website designer and a second website in order to market the
17 first website at the second website upon the activation of the
18 first website on the internet, the method comprising:

19 [1] during design of the first website, receiving

20 information at a user interface indicating a type of an
21 element for marketing

22 that is to be displayed at the second website, and

23 information specifying the second website at which the
24 element is to be displayed;

25 [2] saving the information at a first database that is coupled to
26 the user interface;

[3] obtaining the element for marketing of the type indicated;
and

[4] causing the display of the element for marketing at the
second website

when the first website is activated with respect to the
internet,

wherein the element for marketing includes at least one
of

a banner ad concerning the first website and
a link to the first website.

This appeal arises from the Examiner's Non-Final Rejection, mailed June 18,
2007. The Appellant filed an Appeal Brief in support of the appeal on November
19, 2007. An Examiner's Answer to the Appeal Brief was mailed on February 4,
2008. A Reply Brief was filed on April 4, 2008.

PRIOR ART

The Examiner relies upon the following prior art:

Wexler	US 5,960,409	Sep. 28, 1999
Hess	US 6,058,417	May 2, 2000
Moore	US 6,330,575 B1	Dec. 11, 2001
Mason	US 6,401,075 B1	Jun. 4, 2002

REJECTIONS

Claims 13, 16-18, and 20 stand rejected under 35 U.S.C. § 103(a) as
unpatentable over Moore.

Claims 1, 4-12, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as
unpatentable over Mason and Moore.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess.

ISSUES

The issue of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1, 4-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore turns on to whether the art describes, or shows that it was predictable, that (1) during design of the first website, information is received that is to be displayed at the second website and that specifies the second website at which the element is to be displayed, and (2) when the first website is activated with respect to the internet, the display of the element is caused, wherein the element includes a banner ad or a link to the first website. In addition, the issues as to claims 4-6 and 8-10 turn on whether the art describes the limitations added by those dependent claims.

The issues of whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore, in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler, and in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess turn on the resolution of the issues in the rejection of claim 1.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellant's Disclosure

01. Once the design of the new website by the registered user is completed and the new website is posted/activated, the system 100 causes the selected websites of other registered users (i.e., the websites selected during the design of the new website) to display a link and/or banner ad concerning the new website (Spec. 33:9-13).

Moore

02. Moore is directed to providing a scalable distributed Internet commerce system (Moore 1:11-13).

03. Moore describes a method for designing a Web page, to be hosted on a Web page server, and for publishing the Web page at a destination of the customer's choosing. There is also a method for designing a Web page for use in a distributed electronic commerce system having a Web page server and a second server where the Web page server hosts the Web page. The method creates a link to the second server; designs the Web page such that the link can be embedded into the Web page; and embeds the link into the Web page (Moore 3:23-43).

04. Moore describes how the customer goes to a Store Server and begins shopping. When the customer finds a product to buy, he selects that product and the Store Server then jumps to the Store Builder Server by using a Uniform Resource Locator ("URL"). The URL, called a price URL, contains all of the relevant information on the product, and all the information necessary to build a "Buy Page." (Moore 6:12-20.)

05. Moore Fig. 7 shows several regions with information displayed, such that each would be a display region.

06. Moore describes the practice of using audio in HTML documents
(Moore 1:38-42).

Mason

07. Mason is directed to placing advertisements and/or other
communications on multiple websites (Mason 1:5-8).

08. Mason describes obtaining Internet-type advertisements, modifying
those advertisements to fit the designated advertising spaces allotted by
different and unrelated online newspaper websites, automatically placing
those advertisements, monitoring the success of the placed ads and
modifying the ads and their placements to meet dynamic goals of an
advertising campaign (Mason 2:5-12).

09. Mason facilitates the billing of an advertiser. For example, a national
advertiser can purchase advertising space on an online newspaper
website by the number of hits the ad receives or by the number of click-
throughs (Mason 5:4-8).

10. In Mason, the advertiser can upload one or more original ads into a
server which checks the configuration of the ad, and compares that
configuration to specifications of online newspaper website URLs where
the derivative advertisement links are going to be placed. Typically, the
original advertisement must be modified, forming derivative
advertisement links which are then displayed for final approval. If the
reconfigured ad is approved, it is stored for placement (Mason 5:47-58).

Facts Related To The Level Of Skill In The Art

11. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, web design, and web advertising design. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

12. Those of ordinary skill in the art knew at the time of filing that posting an HTML document to a web site such that it was accessible from links to that web site activated that document within the site.

Facts Related To Secondary Considerations

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.

1 Cir. 2003) (claims must be interpreted “in view of the specification” without
2 importing limitations from the specification into the claims unnecessarily).

3 Although a patent applicant is entitled to be his or her own lexicographer of
4 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
5 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
6 definitions in the specification with sufficient clarity to provide a person of
7 ordinary skill in the art with clear and precise notice of the meaning that is to be
8 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
9 an inventor is free to define the specific terms used to describe the invention, this
10 must be done with reasonable clarity, deliberateness, and precision; where an
11 inventor chooses to give terms uncommon meanings, the inventor must set out any
12 uncommon definition in some manner within the patent disclosure so as to give
13 one of ordinary skill in the art notice of the change).

14 *Obviousness*
15

16 A claimed invention is unpatentable if the differences between it and the
17 prior art are “such that the subject matter as a whole would have been obvious at
18 the time the invention was made to a person having ordinary skill in the art.”
19 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406
20 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

21 In *Graham*, the Court held that that the obviousness analysis is bottomed on
22 several basic factual inquiries: “[1] the scope and content of the prior art are to be
23 determined; [2] differences between the prior art and the claims at issue are to be
24 ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383
25 U.S. at 17. *See also KSR*, 550 U.S. at 406. “The combination of familiar elements

1 according to known methods is likely to be obvious when it does no more than
2 yield predictable results.” *Id.* at 416.

3 “When a work is available in one field of endeavor, design incentives and
4 other market forces can prompt variations of it, either in the same field or a
5 different one. If a person of ordinary skill can implement a predictable variation,
6 § 103 likely bars its patentability.” *Id.* at 417.

7 “For the same reason, if a technique has been used to improve one device,
8 and a person of ordinary skill in the art would recognize that it would improve
9 similar devices in the same way, using the technique is obvious unless its actual
10 application is beyond his or her skill.” *Id.*

11 “Under the correct analysis, any need or problem known in the field of
12 endeavor at the time of invention and addressed by the patent can provide a reason
13 for combining the elements in the manner claimed.” *Id.* at 420.

14 *Obviousness and Nonfunctional Descriptive Material*

15
16 Nonfunctional descriptive material cannot render nonobvious an invention that
17 would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir.
18 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive
19 material is not functionally related to the substrate, the descriptive material will not
20 distinguish the invention from the prior art in terms of patentability).

ANALYSIS

Claims 1-3, 7, and 11-21

The Appellant argues claims 1, 7, 11, 12, 19, and 21 as a group². In addition, the Appellant applies the arguments in support of claim 1 as the arguments to the rejections of claims 13-18 and 20. Accordingly, we treat claims 1, 7, and 11-21 as a group and select claim 1 as representative of the group.

37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Mason describes the limitations of claim 1 except for “during the design of the first website causing the display of the element for marketing at the second website when the first website is activated with respect to the Internet.” The Examiner found that Moore described this limitation and that one of ordinary skill knew to combine this with Mason to avoid premature advertising expense before the advertising was launched (Ans. 3-4).

The Appellant argues that (1) Mason fails to describe activity during a website design (App. Br. 7); (2) neither reference describes a problem to which the Examiner proposed a solution as the motivation to combine the references (App. Br. 8); and (3) neither reference describes causing the display of the element for marketing at the second website when the first website is activated with respect to the internet, as claimed (App. Br. 8). Additionally, the Appellant contends that (4) the Examiner failed to clearly identify how the art describes the claim limitations (App. Br. 5-6); (5) the Examiner mischaracterized limitations [1] and [4] (Appeal

² The Appellant included claim 6 in this group (App. Br. 5), but claim 6 depends from claim 4 which is not included in the group. We therefore consider this inclusion of claim 6 to be a typographic error and treat claim 6 with claims 4 and 5 *infra*.

Br. 6-7); and (6) one skilled in the art would not consider the words posted and activated to be equivalent (App. Br. 9).

As to each of these arguments, the Examiner responded that (1) Moore was applied to describe activity during a website design (Ans. 16); (2) Mason described the practice of paying advertising fees based on ad click-throughs and one of ordinary skill knew the disadvantage of placing such an ad before an advertising campaign was ready (Ans. 16-17); and (3) that such display of ad elements for marketing at websites other than the site where the ad was designed was notoriously well known as evidenced by Moore's referral to Price URL's that users publish when the second web site is activated (Ans. 17).

As to the three subordinate contentions, the Examiner responded to (4) by laying out a more detailed analysis of the match between claim limitations and the references (Ans. 14-15); to (5) by finding that the Examiner's paraphrasing of limitations [1] and [4] were made in view of the support for those limitations in the Specification at 33:10-15 (Ans. 15-16); and to (6) by finding the equivalence of the words "posted" and "activated" based on Specification 33:10-15 (Ans. 18).

The Appellant responded to the Examiner's response to argument (2) by stating that the Examiner's position appeared to be based on inherency and that inherency cannot be based on probabilities (Reply Br. 3-4); and contention (5) that the Specification does not support the Examiner's paraphrase, but instead requires that once the design is completed and the website is posted/activated, then the link and/or banner ad is displayed (Reply Br. 5).

We disagree with the Appellants. There is no contention regarding the ubiquitous steps of saving and obtaining data in limitations [2] and [3]. The issues in the remaining limitations [1] and [4] come down to whether the art describes, or

shows that it was predictable, that (1) during design of the first website, information is received that is to be displayed at the second website and that specifies the second website at which the element is to be displayed, and (2) when the first website is activated with respect to the internet, the display of the element is caused, wherein the element includes a banner ad or a link to the first website.

Limitation [1] requires that two items of information be received at a user interface. The location of the user interface is unspecified. The intent of the two items is that they indicate a marketing element type and specify a second site location. However, the verb “indicating” does not require that the information actually be displayed or used to identify the second site, only that the information be functionally capable of doing so in some context. The Examiner relied on Mason to describe this. Mason describes uploading ads into a server which checks the configuration of the ad, and compares that configuration to specifications of online newspaper website URLs where the derivative advertisement links are going to be placed (FF 10). Thus, Mason’s information indicates an advertising marketing element type and specifies a second site location. This information is received at the user interface prior to final approval (FF 10) and is therefore during the design of the website, or at least that particular advertising piece of the second website. The design of any aspect of a web site is a component of the design of the web site itself and thus fits the limitation of occurring during design of the web site. We therefore find the Examiner’s position that Mason describes limitation [1] supported by substantial evidence.

Limitation [4] requires causing the display of the element that includes either a banner ad concerning the first website or a link to the first website for marketing at the second website when the first website is activated with respect to the internet.

1 Limitation [4] does not specify the causation trigger but does require some
2 coincidence of timing between the display and website activation.

3 The verb “is activated” is the passive voice of activate, and thus limitation [4]
4 requires that the display occur when someone or something activates the web site.
5 The Examiner found that Moore described a system for designing websites where a
6 first website is activated with respect to the Internet when the first website is
7 posted to a hosting server (Answer 4; FF 03). The Examiner construed the verb
8 “activate” as equivalent to the verb “post” based on the use of the construct
9 “posted/activated” in the Specification (Ans. 4; FF 01). From this construction, the
10 Examiner found that Moore described causing the display of the element that
11 includes a banner ad concerning the first website at the *first* website when the first
12 website is activated with respect to the internet. The Appellant’s contention (6)
13 *supra* challenged this construction. Certainly activating is not equivalent to
14 posting in general. However, it is notoriously well known that posting an HTML
15 document on a web site, such that links activates that document within that site.
16 Thus, in the limited context of Internet systems, posting is synonymous with
17 activation (FF 12).

18 So the issue remaining is whether it was predictable to cause the display of the
19 element that includes a banner ad concerning the first website at the *second*
20 website when the first website is activated with respect to the internet. The
21 distinction is that now coordination is required to have display of an ad occur at a
22 second site when activation of the target of the ad occurs at a difference site. The
23 Examiner found it was predictable because without such coordination, the risk of
24 incurring advertising costs prior to the availability of the advertised target would
25 cause the advertising campaign to coordinate those events. The Appellant

1 responded with argument (2) *supra* that the references applied fail to show this
2 problem and that inherency cannot be based on probabilities.

3 Claim 1 does not specify how the coordination occurs, only that it occurs. The
4 Appellant does not make any arguments regarding the coordination mechanism.
5 So the sole issue is whether it was predictable at the time of filing.

6 The obviousness analysis cannot be confined by a formalistic
7 conception of the words teaching, suggestion, and motivation, or by
8 overemphasis on the importance of published articles and the explicit
9 content of issued patents. The diversity of inventive pursuits and of
10 modern technology counsels against limiting the analysis in this way.
11 In many fields it may be that there is little discussion of obvious
12 techniques or combinations, and it often may be the case that market
13 demand, rather than scientific literature, will drive design trends.

14 *KSR*, 550 U.S. at 419. “[T]he analysis need not seek out precise teachings
15 directed to the specific subject matter of the challenged claim, for a court can take
16 account of the inferences and creative steps that a person of ordinary skill in the art
17 would employ.” *Id.* 550 U.S. at 418. “[A] court must ask whether the
18 improvement is more than the predictable use of prior art elements according to
19 their established functions.” *id.* 550 U.S. at 417.

20 As the Examiner found, Mason describes the parameters of the problem in that
21 advertising may be billed based on click-throughs (FF 09). Common sense, let
22 alone knowledge of one of ordinary skill, informs one that with such an
23 arrangement, the mechanism that incurs those costs should not be deployed until
24 the advertisement would be effective, *viz.* at activation of the ad target. On the
25 other side, with any new promotional campaign, delay beyond the earliest
26 appropriate start time is counter to the purpose of such promotion. Thus, the time
27 that one of ordinary skill in the promotional arts would display such an ad would

be when the target of the ad is activated. As to the Appellant's argument regarding inherency, this rejection is one of obviousness rather than novelty.

Accordingly we find the Appellant's arguments unpersuasive.

Claims 4-6

Claim 4 depends from claim 1 and requires a reciprocal site. The Appellant argues the Examiner failed to show such reciprocity in the site described in the references (Reply Br. 9). We agree with the Appellant. The Examiner appears to have ignored this limitation in the analysis by construing the term "reciprocal" to mean simply mean a third party (Ans. 19). The Examiner refers to a definition of reciprocal in the Specification at 16:20-25, but we are unable to discern any definition at that section, which only refers to other, rather than reciprocal, sites. Claims 5 and 6 depend from claim 4 and the same argument applies to those claims as well.

Claims 8-10

Claims 8-10 depend from claim 1 and further require providing banner ads, display regions, and sonic effects. The Appellant argues these are missing from the applied references. The Examiner responds that Moore's price URL's are equivalent to banner ads and that Moore show the use of display regions and audio (Ans. 21-22). The Appellant responded that the Examiner failed to show that Moore's price URL's are equivalent to banner ads and that the Examiner failed to show all of the limitations of claims 9 and 10 (Reply Br. 9-10).

We disagree with the Appellant. A banner ad is simply a link in an HTML document. The contents of the ad are non-functional descriptive material and are accorded no patentable weight. *In re Ngai*, 367 F.3d at 1339. Moore shows such links (FF 04). Moore also shows display regions and sonic effects (FF 05 & 06).

1 The general allegation that the Examiner has failed to show all of the limitations is
2 not a specific argument.

3 CONCLUSIONS OF LAW

4 The Appellant has not sustained its burden of showing that the Examiner erred
5 in rejecting claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable
6 over Moore.

7 The Appellant has not sustained its burden of showing that the Examiner erred
8 in rejecting claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable
9 over Mason and Moore.

10 The Appellant has sustained its burden of showing that the Examiner erred in
11 rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and
12 Moore.

13 The Appellant has not sustained its burden of showing that the Examiner erred
14 in rejecting claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason,
15 Moore, and Wexler.

16 The Appellant has not sustained its burden of showing that the Examiner erred
17 in rejecting claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over
18 Mason, Moore, and Hess.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 13, 16-18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Moore is sustained.
- The rejection of claims 1, 7-12, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore is sustained.
- The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Mason and Moore is not sustained.
- The rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Wexler is sustained.
- The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Mason, Moore, and Hess is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

JRG

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